

REMARKS

The amendment is responsive to the Office Action dated September 21, 2000. Applicant amends 6 and adds claims 7-10 to protect other features of the invention. Claims 6-10 are pending. Reconsideration and reexamination of the application is respectfully requested at an early date.

With regard to page 2, paragraph nos. 1-2, the Examiner asserts that claim 6 is rejected under 35 USC 112, second paragraph, as being indefinite. To address this rejection, the applicant will cite to the columns and lines of the grandparent U.S. Patent No. 5,754,582 to Dong, which has the same specification.

The Examiner asserts that it is not clear within the context of claim what constitutes an upper case and how it is for mounting the rotating shaft. A claim is definite if those of ordinary skill in the art would understand the claim in light of the specification. Even if the Examiner finds the limitations unclear when looking at just the claim language, the specification clearly describes examples of what may constitute the upper case. The upper case is labeled 2 in Figures 8, 9A, 13A, 13B, and discussed, e.g., in the column 6, lines 10-41. Claim 6 as amended also clarifies that the upper case rotatably supports the rotating shaft. Support for the amendment is found, for example, in the specification where it describes that an upper case 2 includes an orifice 5 for holding a bearing 28 for rotatably supporting the rotating shaft 37. It is submitted that this one example clarifies what constitutes an upper case and how the upper case supports the shaft. Although the upper case and lower case perform different functions, it is not essential that they be separate structures or that the upper case be above the lower case in operation.

The Examiner also asserts that a laser projecting a beam expresses a desired result, but fails to recite the structure and/or means necessary to provide that result. Applicant amends claim 6 to clarify a laser diode is the structure for projecting the beam, Laser diodes were well known on the date of the invention by those of ordinary skill in the field and no added description is required in the claims.

The Examiner asserts that where and how the module housing is attached to the rotating shaft is also indefinite. Again, those of ordinary skill would understand this relationship from review of the specification. For example, Figure 7 shows a module housing 36 and a rotating shaft 37 in a

1 T-shaped arrangement, which could be, e.g., a single unitary structure, e.g., machined, or
2 multiple structures attached together in a known manner. Amended claim 6 provides an
3 antecedent basis for the center ray as requested by the Examiner.

4 The Examiner finds it unclear whether the module housing, the mechanical axis in the housing,
5 or both contain the laser. As shown in Figure 7, the module housing 36 shown in the alignment
6 station includes two holes 91 and 93, containing the laser diodes 38 and 39, respectively. This
7 is described in columns 5, lines 48-50. The two cross bars in the center of laser diodes 38 and
8 39 indicate the mechanical axis of the laser diodes 38 and 39, or alternatively the center axis of
9 holes 91 and 93, and of course, cannot also be viewed as "containing" the laser diodes. In view
10 of the above, it is submitted that claim 6 meets the distinctness requirement of 35 USC 112.

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12 With regard to page 2, paragraph nos. 3-4, the Examiner asserts that the amendment filed on
13 August 23, 2000 introduces new matter into the specification. Specifically, the Examiner asserts
14 that adding the motor is "adapted to drive the shaft more than 360 degrees in a single direction"
15 constitutes new matter and applicant needs to point out where the specification supports this.
16 The specification on column 9, lines 16-26, states that when the laser operates in plane mode,
17 the motor 14 rotates the main pulley 24 and the upper magnets 26 attract lower magnets 26
18 which are attached to freewheel 32. Since the free wheel 32 is attached to the main shaft 37,
19 the shaft 37 travels many rpm, and clearly more than 360 degrees in one direction. Given the
20 support for this limitation, it is submitted the new matter objection is overcome.

21 With regard to pages 3-6, the Examiner rejects claim 6 under 35 USC 102(b) as anticipated by
22 or under 35 USC 103(a) obvious over U.S. Patent No. 5,144,120 to Krichever et al. (Krichever
23 '120) or U.S. Patent No. 5,401,948 to Krichever et al. (Krichever '948)(collectively, Krichever
24 '120 and '948). The Examiner asserts Figure 1A of Krichever '120 and '948 discloses the center
25 ray of the beam is perpendicular to the shaft, and that although Krichever '120 and '948 do not
26 describe the shaft being rotated more than 360 degrees in a single direction, they could since it
27 is known shafts can be rotated more than 360 degrees.

28 A claim is anticipated only if each and every element set forth in the claim is found, either
29 expressly or inherently, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of
30 California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Krichever '120 and '948 both fail to disclose
all of the elements of claim 6. For example, Krichever '120 and '948 state that the output shaft

1 22 is repetitively driven in arc lengths of less than 360 degrees in each direction (Krichever '120
2 col. 5, lines 22-25 and Krichever '948 col. 4, lines 63-66). By contradistinction, claim 6 requires
3 "a motor coupled to the shaft adapted to drive the shaft more than 360 degrees in a single
4 direction." Such arrangement permits the laser level of claim 6 to delineate a reference plane.
5 Because the Krichever references do not provide for such arrangement, they cannot anticipate
6 claim 6. Therefore, there cannot be anticipation of claim 6 and it is respectfully submitted that
7 the rejection of claim 6 under 35 USC 102(b) is defective and should be withdrawn.

8 In addition, the Examiner has improperly modified Krichever '120 and '948 because he has not
9 produced a *prima facie* case of obviousness for several reasons. See MPEP § 2142, at 2100-
10 108 ("If the examiner does not produce a *prima facie* case, the applicant is under no obligation
11 to submit evidence of nonobviousness.").

12 A *prima facie* case of obviousness is established when the Examiner shows: (1) some
13 suggestion or motivation to combine the reference teachings; and (2) that the prior art must
14 teach or suggest all the claim limitations. *Id.* In the present case, neither requirement has been
15 met.

16 At this time, no suggestion or motivation to modify Krichever '120 and '948 as suggested exists
17 since any such modification made to obtain the claimed invention would render Krichever '120
18 and '948 unsatisfactory for their intended purpose. MPEP § 2143.01, at 2100-110 ("If a
19 proposed modification renders the prior art invention being modified unsatisfactory for its
20 intended purpose, then there is no suggestion or motivation to make the proposed
21 modification.") (Citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)).

22 In the present case, the Krichever references provide a hand-held scanner with an oscillating
23 shaft for scanning a bar code without projecting a beam that reaches the operator or a
24 customer. If the scanner is modified as suggested by the Examiner, the projected beam would
25 reach the operator or a customer. In other words, the suggested modification would render the
26 prior art device unsatisfactory for its intended purpose. Therefore, no suggestion or motivation
27 to modify Krichever exists. Accordingly, the Examiner has failed to establish a *prima facie* case
28 of obviousness, and should thus withdraw the rejection.

29 Furthermore, Krichever '120 and '948 fail to teach all the claimed limitations. In the present
30 case, the claim calls for a laser level system. As discussed above, Krichever '120 and '948
disclose a hand-held bar code scanner, not a laser level system. Similarly, Krichever '120 and
'948 fail to disclose a center ray perpendicular to the rotating shaft. Even if the Figure 1A center

1 ray might appear to the Examiner as perpendicular to the shaft, there is no apparent disclosure
2 in Krichever '120 and '948 on how to actually achieve perpendicularity as recited in claim 6. And
3 Krichever '120 and '948 present no motivation to achieve this perpendicularity because they
4 deal with hand held bar code scanning. Such perpendicularity is not required, because the bar
5 code is held close to the hand held scanner and the bar code itself is large such that the center
6 ray need not be perpendicular with the shaft. This contrasts with a laser level system, which
7 must maintain the center ray perpendicular to the shaft to project a useable line on a surface at
8 a distance, for example, for construction work, such as hanging dry wall. There is no motivation
9 to modify the Krichever '120 and '948 laser scanners to work more precisely than necessary for
10 an added cost. In view of the above, Krichever '120 and '948 do not anticipate nor would they
11 have rendered claim 6 obvious before or after entry of the 35 USC 112 amendments requested
12 here.

13 New claims 7-10 are allowable for similar reasons as well as for the different features recited
14 therein.

15 Please call the undersigned if it will expedite the progress of the application.
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20 Respectfully submitted,

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